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Date: April 25, 2008

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Applicants: Teresa Martineau, *et al.*

Examiner: Mark A. Fadok

Serial No: 09/698,379

Art Unit: 3625

Filing Date: November 27, 2000

Title: WISH LIST

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

Applicants' representative submits this Reply Brief in response to the Examiner's Answer dated February 25, 2008. In the event any additional fees may be due and/or are not covered by the credit card, the Commissioner is authorized to charge such fees to Deposit Account No. 50-1063 [MSFTP151US].

I. Status of Claims (37 C.F.R. §41.37(c)(1)(iii))

Claims 12-40 have been withdrawn. Claims 1-11, 41-49 stand rejected by the Examiner. The rejection of claims 1-11, 41-49 is being appealed.

II. Grounds of Rejection to be Reviewed (37 C.F.R. §41.37(c)(1)(vi))

A. Claims 1, 2, 5-7, 9-11, 41, 42 and 45-48 stand rejected under 35 U.S.C. §102(e) as being unpatentable over Lee (6,611,814).

B. Claims 3, 4, 43 and 49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Hsu (7,013,292).

C. Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of NetGift (a collection of articles and web pages).

III. Argument (37 C.F.R. §41.37(c)(1)(vii))**A. Regarding the Rejection of Claims 1, 2, 5-7, 9-11, 41, 42, 45, 46, 47, 48 Under 35 U.S.C. §102(e)**

Claims 1, 2, 5, 6, 7, 9, 10, 11, 41, 42, 45, 46, 47, 48 under 35 U.S.C. §102(e) as being anticipated by Lee (U.S. Patent No. 6,611,814). It is respectfully submitted that this rejection should be withdrawn for the following reasons. Lee does not disclose or suggest each and every element set forth in the subject claims.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that “*each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.*” In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Applicants' claimed invention relates generally to creating an electronic shopping list (*e.g.*, a list of references to items) for a user and utilizing this list to purchase items for the user over the Internet. (*See Specification, page 2, lines 9-11*). The systems and methods of the present invention provide a user interface that enables the user to create a personalized list of references to items (*e.g.*, offers, product categories, products from merchants, products from manufacturers...) by electronically selecting and adding such items to their item list. (*See Specification, page 2, lines 11-17*). This list of references, as well as other users' item lists, is stored within an item list database (*See Specification, page 2, lines 17-18*). Information related to items (*e.g.*, offer, manufacturer and merchant information) is stored within one or more item databases. (*See Specification, page 6, lines 7-17*).

In general, an owner of an item list or a customer who intends on purchasing an item for owner of the item list can request the stored item list. On request, an interface component utilizes item references from the stored item list to extract related item data from the item databases. The extracted data is employed to present a list of items to a requester ensuring that current item information from the item databases is provided. (*See Specification, page 7, lines 5-10*).

The cited reference Lee discloses a system and a method for generating *virtual wish lists* for assisting shopping over computer networks. Lee discloses a system that provides for virtual wish lists, while not requiring the users to register to online stores for using the wish list service, and *not requiring the users to add products to buy to their wish lists*. (*See, column 2, lines 59-64*). Lee further discloses that "a virtual wish list 900 is automatically created, and it keeps information of product its owner is interested in by using the information collected from Web pages the person request and examines in the Internet." (*See column 6, lines 24-30*). On the other hand, the claimed subject matter relates to a system and a method that provides for a user interface that enables a user to create a personalized list of references to items (*e.g.*, offers, product categories, products from merchants, products from manufacturers...) by electronically selecting and adding such items to their item list. This list of references, as well as other users' item lists, is stored within an item list database. (*See Specification, page 2, lines 11-18*). It is therefore readily apparent that Lee teaches away from the claimed subject matter of a system with an interface that facilitates a user to create wish lists for items residing on the Internet, as

Lee's system relates to a *virtual wish list*, which automatically creates a wish list from information collected from users' web interaction.

Claims 1, 41, and 47

Independent claim 1, in part, recites an *interface component that receives a request to display the item that is referenced in the item list, accesses the item list database to obtain the reference from the item list, utilizes the reference as a key into the item database and retrieves data corresponding to the referenced item from the item database and utilizes the retrieved data to display the item and associated information to the requester*. Similarly, independent claim 41 recites an item list including a reference to an item stored in an item database, where the *reference is utilized as a key into the item database to extract data corresponding to the referenced item from the item database and to display the referenced item and associated information*. In addition, independent claim 47 recites a means for *receiving a request to display the referenced item, retrieving the reference, utilizing the reference as a key into the stored information, extracting data corresponding to the referenced item and utilizing the extracted data to display the item and associated information to the requester*. Lee fails to disclose or suggest any such interface component that allows the user to retrieve and display a wish list of items available on the internet. In fact, as mentioned *supra*, Lee teaches away from such an invention as it relates to automatic creation of virtual wish lists based on the user's web interaction and not relates to a system that allows a user to interact with an interface to create wish lists based on the information available on the web.

Furthermore, claims 1, 41, and 47 recites *utilizing reference to items* to extract items from the item database. The use of references stored in an item list to extract information from an item database for display of an item provides several advantages. By utilizing references to items to extract items from the item database rather than simply copying the data into the item list database on a periodic basis, the system ensures that the displayed item information is current. Modifications to the item database will be automatically reflected when the item lists are displayed to users. For example, if the price of an item is increased in an item database, the increased price will be automatically retrieved from the information database when item lists are displayed to users without requiring a separate update of effected item lists. Similarly if a particular item is not available, the information is automatically retrieved from the information

database without requiring a separate update of effected item lists.). Such a technique is possible by utilizing **references to items to extract items from the item database**, instead of directly retrieving information from the database system. Lee is completely silent with respect to utilizing any such **references to items to extract items from the item database** and therefore fails to provide an item list that has current product information. In fact, Lee discloses that: “sometimes it is possible that certain products in the shopping list (which uses the information from virtual wish list) are not available in the store 120 where the shopping list 1100 is submitted. Then the store 120 **may not** be able to **have entries for such products** the recommended product list 1200”. (See column 13, lines 41-46). Therefore, it is readily apparent that Lee fails to disclose or suggest each and every element of the claimed subject matter.

In view of at least the foregoing, it is requested that this rejection should be withdrawn with respect to independent claims 1, 41 and 47 (and the claims that depend there from).

Claims 2, 42, and 48

Dependent claims 2, 42 and 48 recite similar aspects. In particular, claim 2 recites the **interface component degrades the display of the item as records are removed from the item database**, claim 42 recites **degrading the display of the item as records are removed from the item database** and claim 48 recites **means for degrading the display of the item as records are removed from the stored information**. As disclosed in the subject application, when an item in a user’s item list is removed from the item database, the data can be degraded to provide a user with an alternate item from the database and/or another database, such as the best available item. The degraded list can provide users with a link to a merchant’s web site or to alternative, similar items. (See Application, page 7, lines 12-24). Lee fails to disclose or suggest any such degrading of the display of the items as records are removed. In fact, as mentioned *supra*, Lee discloses that: “sometimes it is possible that certain products in the shopping list (which uses the information from virtual wish list) are not available in the store 120 where the shopping list 1100 is submitted. Then the store 120 **may not** be able to **have entries for such products** the recommended product list 1200”. (See column 13, lines 41-46). Therefore, it is readily apparent that Lee fails to disclose or suggest the novel features of the subject claims.

Claims 5-7, and 45

Dependent claims 5 and 45 recite similar aspects. In particular, claim 5 recites *a remote input component that allows a user to add an item to the item list, the item is a description that resides on a remote merchant's site.* Similarly, claim 45 recites *allowing a user to select an item from an electronic website to add to the item list and adding the selected item to the item list.* As mentioned *supra*, Lee relates to virtual wish list generation and does not disclose an input component that allows a user to add an item to the item list. Therefore, it is respectfully submitted the rejection of claim 5 (and claims 6-7 which depend there from) and claim 45 be withdrawn.

Claim 10

Dependent claim 10 recites *at least one HTML page that allows a user to select items from an electronic web-site to add to the item list and at least one element that provides a link from a selected item to the interface component, the interface component adds the selected item to the item list.* As mentioned *supra*, Lee's system which relates to a virtual wish list fails to disclose or suggest a system that allows users to select items to add to an item list. Therefore, it is respectfully submitted the rejection of claim 10 be withdrawn.

B. Rejection of Claims 3, 4, 43 and 49 Under 35 U.S.C. §103(a)

Claims 3, 4, 43 and 49 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Hsu (7,013,292). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Lee and Hsu, individually or in combination, do not teach or suggest each and every element set forth in the subject claim. In particular, Hsu does not make up for the aforementioned deficiencies of Lee with respect to independent claims 1, 41 and 47 (which claims 3, 4, 43, and 49 depend there from). Therefore, the claimed invention as recited in claims 3, 4, 43, and 49 is not obvious over the combination of Lee and Hsu. Thus, it is respectfully submitted that this rejection be withdrawn.

C. Regarding the Rejection of Claim 6 Under 35 U.S.C. §103(a)

The rejection of claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of NetGift (a collection of articles and web pates see PTO 892, Netgift1—Netfit7).

It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Lee and NetGift, individually or in combination, do not teach or suggest each and every element set forth in the subject claim. In particular NetGift does not make up for the aforementioned deficiencies of Lee with respect to independent claims 1 (which claim 6 depends there from). Therefore, the claimed invention as recited in claims 6 is not obvious over the combination of Lee and NetGift. Thus, it is respectfully submitted that this rejection be withdrawn.

D. Conclusion

The subject application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP151US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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